

REMARKSAmendments to the Claims

Claims 3, 5-8, and 10, 12 and 13 are currently pending.

Claims 5, 7, and 10-12, directed to processes are allowed.

Claims 3, 6 and 8 are directed to compounds or compositions and remain rejected. Claim 6 is amended to recite the Markush groups for R and Y that are set forth on page 6 lines 11-14 and page 14, second paragraph, of the specification respectively

No new matter has been added.

Rejections Under 35 USC § 103

The Examiner has rejected claims 3, 6 and 8 as obvious over Hayashi et al in view of Kuramochi et al. The difference between the compound of the prior art and the instantly claimed compound is that in the prior art R is methyl while in the instant invention R is tert-butyl (claim 3) or some other simple alkyl group (claim 6). The Examiner states that in the absence of a showing of unobvious results the instantly claimed invention is obvious.

The Examiner has not yet been persuaded of unobviousness of the invention on the basis of the first Kakeya Declaration filed April 24, 2007. The Examiner at first indicates that the Declaration is not persuasive because the experimental showing demonstrates only a 5-fold difference in the activity of the claimed compounds compared to the prior art, and that this is simply not unexpected. The Examiner next argues that Dr. Kakeya's Declaration does not reach a conclusion that the result shown is unexpected. Finally, the Examiner proffers a teaching of a structure-activity relationship (SAR) taught by Nagumo (2004) as evidence that the part of the molecule of the invention distinct from the prior art compound is one that would not be expected to influence the activity of the compound.

As a threshold matter, Applicants submit that the Examiner improperly substitutes his judgment for that of one of ordinary skill in the art in disputing Dr. Kakeya's conclusion about obviousness of the claimed invention. See, *In re Katschmann*, 146 USPQ 66 (CCPA 1965).

Applicants concede that Dr. Kakeya's Declaration does not conclude expressly that the result observed is "unexpected", but does conclude that the result is unobvious.

Nonetheless, so as to address this point more directly, submitted herewith is a second Declaration by Dr. Kakeya that addresses each of the points made by the Examiner, and expressly concludes that the experimental results of his first Declaration are indeed "unexpected".

Second, the Examiner's argument that Nagumo (2004)¹ teaches that the portion of the molecule differing between the instant invention and the prior art is one that has little influence on the activity of the molecule implies that in fact the change in the R group should not have any substantial effect on the activity. Therefore, contrary to the Examiner's position, to see a 5-fold change in activity by modification of the R group should in fact be admitted to be an unexpected result.

Applicants submit that the unobviousness of the present invention is well-demonstrated by the evidence of record in this application, and so this rejection should be withdrawn.

In view of the above, Applicants submit that the claims are in a position for allowance and request that all rejections be withdrawn.

If the Examiner has any questions concerning this application, the Examiner is strongly urged to contact the undersigned at the telephone number below to discuss this matter.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to our Deposit Account 02-2448 for any additional fees required under 37.C.F.R. § 1.16 or under § 1.17, particularly extension of time fees.

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Respectfully submitted,

By: 

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Attachment: 2nd Kakeya Declaration

¹ The Examiner should further consider that, being published almost two years after the priority date of the present application, Nagumo (2004) was not available at the time the invention was made, *i.e.* at the time obviousness is to be considered, to guide development of the compounds of the present invention.